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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,421	12/12/2001	Amarjit Tathgur	SHW100002000	5717

22891 7590 09/23/2003

DELIO & PETERSON
121 WHITNEY AVENUE
NEW HAVEN, CT 06510

EXAMINER	
LEUNG, PHILIP H	
ART UNIT	PAPER NUMBER
3742	7

DATE MAILED: 09/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/015,421	TATHGUR ET AL.	
	Examiner	Art Unit	
	Philip H Leung	3742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) *8-13* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7,14 and 15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *12 December 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *5 and 6* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. **Claims 1-7, 14 and 15**, drawn to a method for inductively heating a substrate and a coating on the substrate, classified in class 219, subclass 634.

   II. **Claims 8-10**, drawn to a method of repairing an opening in a coating on a substrate, classified in class 156, subclass 94.

   II. **Claims 11-13**, drawn to a method of applying a coating or covering a weld joint between tubular structures, classified in class 156, subclass 84.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions *Group I* and *Group II* are related as process of making and process of using. In the instant case, the heating process of *Group I* could be used to heat a variety of coated substrates for a variety of reasons other than to apply a patch for repairing an opening in the coating, such as for bonding a protective layer to a pipe or a cooking pan.

Inventions *Group I* and *Group III* are related as process of making and process of using. In the instant case, the heating process of *Group I* could be used to heat a variety of coated

substrates for a variety of reasons other than to apply a coating or covering to a weld joint between tubular substrates, such as for repairing an opening in the coating as in *Group II*.

Inventions *Group II* and *Group III* are distinct processes. Each group relies on different elements for patentability not required by the other. Group II (Figures 2 and 3) requires repairing an opening in a coating by applying a patch thereto whereas Group III (Figure 1) requires applying a coating or covering to a weld joint between tubular substrates each having a coating thereon.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and because of their recognized divergent subject matter and the search required for *Group I* is not required for *Group II* and vice versa, restriction for examination purposes as indicated is proper.

4. During a telephone conversation between Examiner Jessica Rossi and Attorney Peter Peterson on August 26, 2003 a provisional election was made with traverse to prosecute the invention of *Group I*, **claims 1-7, 14 and 15**. Affirmation of this election must be made by applicant in replying to this Office action. **Claims 8-13** are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

6. The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to **Group Art Unit 3742**.

7. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The title should be amended to reflect elected invention.

8. The drawings filed 12-12-01 are acceptable.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

10. **Claims 1-7, 14 and 15** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Yoshida* (JP 3-244527) (cited by the applicants), in view of *Shiozaki* (US 5,504,308) or *Buckley et al* (US 5,919,387).

Yoshida discloses the claimed method for heating a substrate (pipe 1) and a coating (material 4) on the substrate comprising applying on the coating a n auxiliary heating means (6), such as a ribbon heater, heating plate heater or the like and heating the substrate and the coating with an induction heater (see Figure 1 and the English abstract and a translated portion provided by the applicant). It appears that the auxiliary means 6 such as a ribbon heater, heating plate heater or the like, may be inductively heatable although it is not explicitly stated in the translated portion. Anyway, *Shiozaki* shows that it is well known in the art of inductively heating thermoplastic resin pipes to include susceptors which are induction heat generating layers (2, 22, 23, 24) to provide additional heat in response to the induction heaters E, for heating the desired areas of the pipe (see Figures 1-4 and col. 3, line 32 - col. 4, line 20). *Buckley* also shows that it is well known in the art of induction heating pipes to use a susceptor (50) to induce heating by the

induction heater. (see Figures 2-6 and col. 3, line 62 - col. 6, line 3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify *Yoshida* to use an induction generating susceptor as the auxiliary heating means so that it can generate heat in response to the induction heater without the use of another heat source for better heating efficiency and lower cost, in view of the teaching of *Shiozaki* or *Buckley*. In regard to claims 2-4, Buckley shows that the susceptor is coupled with an insulated coating (see col. 4, lines 1-5). In regard to claim 5, Buckley shows that the susceptor 50 is perforate in Figure 2. In regard to claims 6 and 7, *Shiozaki* shows the use of both open circuit susceptors (Figures 2 and 3) and closed circuit susceptors (Figure 1). In regard to claims 14 and 15, the use of polypropylene coatings on plastic pipes is well known (see paragraph [002] of the specification).

11. The prior art made of record below is considered pertinent to applicant's disclosure:

Formanack et al (US 4,818,833) is cited to show the use of insulated layers (44, 46, 50) around the susceptor 36 in an induction heating device.

12. Effective May 1, 2003, the address for mail to the USPTO is:

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

13. Any inquiry concerning any communication from the examiner should be directed to Examiner Leung whose telephone number is (703) 308-1710. The examiner can normally be reached on Monday to Friday from 8:00 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg, can be reached on (703) 308-1327. The fax phone number for this Group is (703) 872-9302

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0861.

PHILIP H. LEUNG
PRIMARY EXAMINER
ART UNIT 3742

P.Leung/pl
9-17-03

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-7 and 14-15, drawn to a method for heating a substrate and a coating on the substrate, classified in class 219, subclass 634.

II. Claims 8-10, drawn to a method of repairing an opening in a coating on a substrate, classified in class 156, subclass 94.

III. Claims 11-13, drawn to a method of applying a coating or covering to a weld joint between tubular structures, classified in class 156, subclass 84.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and process of using. In the instant case, the process could be used to heat a variety of coated substrates for a variety of reasons other than to apply a patch for repairing an opening in the coating, thereby placing serious burden on the examiner.

3. Inventions I and III are related as process of making process of using. In the instant case, the process could be used to heat a variety of coated substrates for a variety of reasons other than to apply a coating or covering to a weld joint between tubular substrates, thereby placing serious burden on the examiner.

4. Inventions II and III are distinct method of using combinations. Each group relies on different elements for patentability not required by the other. Group II (Figures 2-3) requires repairing an opening in the coating by applying a patch thereto whereas Group III does not.

Group III (Figure 1) requires applying a coating or covering to a weld joint between tubular substrates each having a coating thereon whereas Group II does not.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. This application contains claims directed to the following patentably distinct species of the claimed invention: upon election of **Group III**, Applicants must further elect one of the species detailed below.

Species A (appears to be claim 11), drawn to applying a coating.

Species B (appears to be claims 11-13), drawn to applying a covering.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

7. *Please note rejoinder of Groups and Species will be considered upon the discovery of allowable subject matter, depending on the basis thereof.*

8. During a telephone conversation with Mr. Peterson on 8/26/03 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-7 and 14-15. Affirmation of this election must be made by applicant in replying to this Office action. Claims 8-13 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jessica L. Rossi** whose telephone number is **703-305-5419**. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael W. Ball can be reached on 703-308-2058. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Jessica L. Rossi
Patent Examiner
Art Unit 1733

jlr